

REMARKS

In an Office Action mailed on January 16, 2007, claims 43 and 44 were rejected under 35 U.S.C. § 102(e) as being anticipated by Simpson; claim 45 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson; claim 46 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Simpson in view of Patel; claims 25-27 and 31-42, 49 and 50 were allowed; and objections were made to claims 47 and 48 as being dependent upon a rejected base claim but were indicated as being allowable if rewritten in independent form.

Regarding the remaining § 102 rejection of independent claim 43, Applicant respectfully requests the Examiner to consider all limitations of this claim. In particular, Applicant directs the Examiner's attention to the recitation of a mechanism adapted to *release* at least some of the potential energy to radially expand the energizing element (*emphasis added*). In the Final Office Action, the Examiner labels the ratchet ring 71 as the alleged mechanism of independent claim 43. *See, for example*, Final Office Action, 2. However, Simpson describes the ratchet ring 71 as a "one-way ratchet ring," which therefore cannot be operated to release potential energy stored in the tubing 62. Simpson, paragraph no. 46. As such, a *prima facie* case of anticipation has not been set forth for independent claim 43, as Simpson fails to teach a mechanism to both 1.) hold an energizing element in a first position prior to a packer being into a well to store potential energy; and 2.) release the energizing element downhole to release some of the potential energy. Therefore, for at least this reason, Applicant requests withdrawal of the § 102 rejection of claim 43.

Claims 44-46 are patentable for at least the reason that these claims depend from an allowable claim for the reasons that are set forth above.

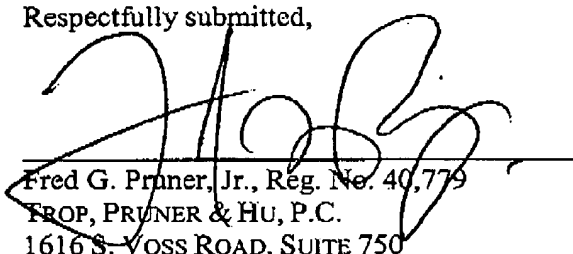
Regarding the Examiner's response to the challenge to the Official Notice, the Examiner did not provide any reference that shows the alleged suggestion or motivation to modify Simpson to replace the one-way ratchet ring 71 with a pin. In this regard, a *prima facie* case of obviousness has not been set forth for claim 46 for at least the reason that the Examiner fails to show where the prior art contains the alleged suggestion or motivation for the proposed modification. In other words, the Office Action must provide reference(s) that contain a suggestion or motivation that would have led one skilled in the art, *without knowledge of the claimed invention*, to modify Simpson to replace the one-way ratchet mechanism 71 with a pin. Not only has the purported suggestion or motivation not been shown, it is unclear how Simpson's

system would even work (i.e., how the tubing 62 would be expanded) using a pin. The Examiner appears to be relying on the alleged general level of skill in the art to supply the purported suggestion or motivation. However, rarely will the general level of skill in the art sustain a case of obviousness. *At-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999).

Thus, for at least the foregoing reasons, Applicant respectfully requests withdrawal of the remaining §§ 102 and 103 rejections of claims 43-46 and a favorable action in the form of a Notice of Allowance. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0268US).

Respectfully submitted,

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